

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gunter Farin et al.

Application No.: 10/525,802

Confirmation No.: 1166

Filed: July 18, 2005

Art Unit: 3739

For: APPLICATOR FOR AN ELECTROSURGICAL
INSTRUMENT

Examiner: V. W. Chen

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

In response to the restriction requirement set forth in the Office Action mailed January 23, 2009, Applicants hereby provisionally elect Group I, claims 20, 21, 23-42, 44 and 47, with traverse, for continued examination.

The Office Action asserts that the application lacks unity in that it contains three groups of inventions that are not linked to form a single general inventive concept under PCT Rule 13.1. The Office Action states that the three groups of inventions mutually lack the same or corresponding "special technical features." As defined in PCT Rule 13.2, "[t]he expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

As discussed in MPEP §1850, lack of unity of invention may be directly evident "*a priori*" that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*" that is, after taking the prior art into consideration. The Office Action does not make reference to any prior art, let alone to the respective contribution that each of the claimed

inventions makes over the prior art. Accordingly, the Office Action provides *a priori* restriction. However, *a priori* conclusion that any of the claims lack unity is not justified.

Independent claim 20 recites, *inter alia*, “a gas and high frequency current supply pipe formed of an electrically conductive material, said electrically conductive material of said pipe conducting a high frequency current that drives a cutting electrode.”

Similarly, independent claim 39 recites, *inter alia*, “a supply pipe formed of an electrically conductive material, wherein said electrically conductive material of said pipe conducts a high frequency current that drives an electrode to said electrode.”

Independent claim 48 also similarly recites, *inter alia*, “a gas and high frequency current supply pipe formed of an electrically conductive material said electrically conductive material of said supply pipe providing a sole means of conducting a high frequency current that drives a cutting electrode from a gas and high frequency current terminal to said cutting electrode.”

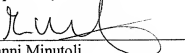
Last but not least, independent claim 50 similarly recites, *inter alia*, “a supply pipe formed of an electrically conductive material, wherein said electrically conductive material of said supply pipe conducts a high frequency current that drives an electrode from a gas and high-frequency current terminal to said electrode.”

Given the close similarity of the aforementioned features of the independent claims, Applicants believe that the unity of the subject matter of independent claims 20, 39, 48 and 50 cannot be questioned *a priori*, i.e., before considering the claims in relation to the prior art.

In light of the fact that the claims recite similar limitations, it is improper to make a determination regarding lack of unity *a priori*. Since all of the independent claims recite a similar feature and the Office Action has not demonstrated *a posteriori* lack of unity (no assessment of the contribution that each of the claimed inventions, considered as a whole, makes over the prior art, was provided), Applicants respectfully request withdrawal of the restriction requirement. Favorable action on the merits is earnestly solicited.

Dated: February 23, 2009

Respectfully submitted,

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